

In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicants' disclosure.

Applicants respectfully submit that the Office Action fails to satisfy at least the first criteria. Specifically, according to MPEP §2143.01(V), the Office Action has failed to provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings.

MPEP §2143.01(V) states that if the proposed modification of a reference would render the invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. The Office Action suggests that it would have been obvious to the skilled artisan to modify the system and method of Price by the alleged teachings of Golovchinski and Lawton to arrive at the claimed invention. However, Applicants respectfully submit that such a modification of the system and method of Price would render the system and method of Price unsuitable for their intended purpose.

In particular, Price discloses a system and method whereby a user may annotate a document (p. 32-33). Based on the annotations, the system and method create a query (p. 34). The query is then used to search a database of documents (p. 36). Documents returned by the search ("target documents" in the context of Price), and related to the annotations are presented to the user, for example, as links in the margin or at the end of the document that is

annotated with the annotated words underlined in the returned documents. Importantly, because the device and method of Price both create a query and use the query to search, the system and method of Price locate new and unknown documents from the database. This is done in Price based on the assumption that the returned new and unknown documents will be useful to the user by providing additional new and unknown information to the user (p. 33-34).

The Office Action alleges that Lawton teaches the pre-selection of "target documents." However, were Price modified by the Office Action's alleged teaching of Price to pre-select target documents, before the source document is annotated, then both the creation of a query function and the search for documents based on the query function of Price would be unnecessary. That is, there would be no reason to create a query for a search and then search for documents based on the query if the target document is already pre-selected and known to the system. Importantly, if the system and method of Price were modified as suggested by the Office Action such that the target document was pre-selected, the system and method of Price would be incapable of providing a user with new and unknown documents from the database (although this intended purpose is discussed throughout Price, it is clearly evident, for example, from Price's discussion of "serendipity," on page 33). Thus, Price would be rendered unsuitable for its intended purpose.

Because, the modification of Price suggested by the Office Action would render the system and method of Price unsuitable for its intended purpose, there can be no motivation for such a modification (MPEP §2143.01(V)). Because there is no motivation to modify Price as suggested by the Office Action, the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-7, 9-16, 18, and 19.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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